

REMARKS

Claims 1-12 and 14-38 are pending in the application. In the Office Action dated August 18, 2003, claims 1-3, 6-12, 15-23 and 25-38 were rejected under 35 U.S.C. § 103(a) as being obvious over Miyamoto (U.S. 5,793,973) in view of "Messaging next blockbuster hit" by Cox. Claims 4, 5, 14 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyamoto and Cox, and further in view of Shinomura (U.S. 6,108,709). The declaration pursuant to 37 C.F.R. § 1.131 submitted with the response filed on September 11, 2002 (the first declaration) was deemed ineffective for lack of showing diligence between the date of conception and actual or constructive reduction to practice of the invention.

Applicant requests withdrawal of these grounds of rejection in view of the following Remarks and a new declaration pursuant to 37 C.F.R. § 1.131 (the second declaration) with accompanying exhibits submitted herewith.

The Examiner has recognized that the first declaration by the inventor provided evidence sufficient to demonstrate conception of the claimed invention prior to the effective dates of Miyamoto and Shinomura. The undersigned request the Examiner to note that paragraph 4 of the first declaration contained the following statements of inventor:

I prepared invention disclosure number 97.03844 corresponding to pages 1-4 of Exhibit A. The invention disclosure was submitted to my employer, Micron Electronics (and later assigned to the present assignee, Micron Technology, Inc), for the purpose of preparing a patent application. The invention disclosure statement was thereafter submitted to patent counsel for preparation of the present application.

The second declaration by the undersigned, which is submitted herewith to augment the first declaration, further states that the time period between conception of the invention and submission of the disclosure to her employer was less than one month. It further states that the time period between submission of the disclosure to the employer and submission to patent counsel was about 1 month, which is well within a reasonably diligent time period, especially for an entity as large as the assignee of the present invention who receives numerous invention disclosures and files hundreds of patent applications per year. Accordingly, Applicant submits that there was reasonable diligence by both the inventor and the employer in moving the

invention from conception to constructive reduction to practice by passing the disclosure to patent counsel for preparation of the application in a timely manner prior to the reference date.

It is assumed therefore, that the Examiner requires further evidence to show reasonable diligence by prior patent counsel. In this regard, the second declaration is submitted by the undersigned attorney based on review of the correspondence history of communication between patent counsel, the employer/assignee and the inventor – as well as the overall workload of prior counsel. The undersigned submits that the second declaration establishes that patent counsel was reasonably diligent in investigating and preparing the instant application, especially in view of the large number of applications for the assignee/employer that were being prepared and prosecuted by prior counsel and other workload of the attorney. It has been held that delay in preparing and filing a patent application based on the workload of a patent attorney is excusable delay that does not negate reasonable diligence in constructive reduction to practice: *Gould v. Schawlow* 363 F.2d 908, 916 (CCPA 1966); *see also, Bey v. Kollonitsch*, 866 F.2d 1024 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if the attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient.);

In the present case, the declaration establishes that patent counsel received no less than 7 invention disclosures from the assignee at the same time, amongst which included disclosure number 97.03844, which established the basis of the instant application. The attorney began work on all the applications prior to the earliest reference date of February 19, 1998. The undersigned notes that four of the disclosures (97.03995, 97.03994, 97.03993 and 97.03844) are in the field of managing electronic messages and therefore related to the instant invention application. It is has been held that work on related applications constitutes diligence on all of the applications, *Ex Parte Ovshinsky*, 10 USPQ2D 1075, 1074 (Bd. Pat. App. & Int'l 1989) ('the inventor and their attorney worried diligently during the relative [sic] time period on a series of closely related patent applications including the one at issue."); *see also, Bey v. Kollonitsch*, (Fed. Cir. 1986) ("work on a related cases(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence").

Moreover, during the relevant period of time between receiving the disclosures and filing the instant application, patent counsel was working on several other applications for the same assignee as well as for other clients. The attached exhibit H shows that prior counsel filed no less than 140 applications for Micron alone during the relevant time period. These 140 applications were prepared and processed by only five or six attorneys of prior counsel. These were handled with reasonable diligence and in chronological order as is customary for prior counsel. *see Rines v. Morgan* 250 F.2d 365, 369 (CCPA 1957) ("it is not necessary that an inventor or his attorney should drop all other work and concentrate on the particular invention involved; and if the attorney has a reasonable backlog of work which he takes up in chronological order and carries out expeditiously, that is sufficient.").

Therefore, pursuant to 37 C.F.R. §1.131(b), Assignee respectfully submits that the combined first and second declarations submitted for the present application demonstrate facts sufficient to establish prior conception, and diligence in constructive reduction to practice from a time prior to the earliest reference date of February 19, 1998 to the date of filing the present application. Accordingly the declarations are sufficient to remove both Shinomura and Miyamoto as prior art.

The declarations are filed to facilitate prosecution of the present applications. Filing of the declarations is not an admission that the combination of Miyamoto, Cox and/or Shinomura renders the claimed invention unpatentable. Applicant may disagree with the merits of the Examiner's rejections of the pending claims over the cited art and therefore reserves the right to further comment on the merits at a latter date if necessary.

All of the claims remaining in the application are now clearly allowable.
Favorable consideration and a timely Notice of Allowance are earnestly solicited.

Respectfully submitted,

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MWR:tlm

Enclosures:

Postcard
Fee Transmittal Sheet (+ copy)
Associate Power of Attorney
Declaration of Mark W. Roberts w/Exhibits A-H

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